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EXAMINER

PASCUA, JES F

| ART UNIT | PAPER NUMBER |
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 07192004

Application Number: 09/978,215
Filing Date: October 15, 2001
Appellant(s): RODRIGUEZ, LUIS J.

Luis J. Rodriguez
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

MAILED
JUL 20 2004
GROUP 3700

This is in response to the reply brief filed September 08, 2003 and the remand by the Board of Patent Appeals and Interferences mailed June 29, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the appeal brief filed March 02, 2003 and reply brief filed September 08, 2003 is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the reply brief filed September 08 2003 is incorrect.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the appeal brief filed March 02, 2003 is substantially correct. The changes are as follows:

I

Claims 45-49 and 68-70 are rejected under 35 U.S.C. 112, first paragraph.

II

The rejection of claims 45-53 under 35 U.S.C. 112, second paragraph is presently withdrawn.

III

Claims 45-47, 62-64 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Schieman.

IV

Claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman.

V

Claims 48, 52, 56 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman, as applied to claims 45, 50, 54, 59 and 62, and further in view of Stenner.

Claims 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman.

(7) Grouping of Claims

Appellant's reply brief filed September 08, 2003 includes a statement that claims 45-59 and 61-70 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the appeal brief filed March 07, 2003 is correct.

(9) Prior Art of Record

| | | |
|-----------|----------|---------|
| 2,367,440 | SCHIEMAN | 01-1945 |
| 2,384,223 | WILBUR | 09-1945 |

| | | |
|-----------|---------|---------|
| 3,027,067 | JOHNSON | 03-1962 |
| 5,607,100 | STENNER | 03-1997 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(I) Claims 45-49 and 68-70 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office Action, Paper No. 12.

(II) The rejection of claims 45-53 under 35 U.S.C. 112, second paragraph is presently withdrawn. This rejection is set forth in prior Office Action, Paper No. 12.

(III) Claims 45-47, 62-64 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Schieman. This rejection is set forth in prior Office Action, Paper No. 12.

(IV) Claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman. This rejection is set forth in prior Office Action, Paper No. 12.

(V) Claims 48, 52, 56, 60 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman, as applied to claims 45, 50, 54, 59 and 62, and further in view of Stenner. This rejection is set forth in prior Office Action, Paper No. 12.

(VI)

Claims 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wilbur or Schieman. This rejection is set forth in prior Office Action, Paper No. 12.

(11) Response to Argument

Regarding appellant's arguments concerning the rejection of claims 45-49 under 35 USC 112, first paragraph, the remark that "claims 45 and its dependent claims 46-49 fully comply with 35 USC 112" is opinion.

Appellant's arguments in Amendment C (pgs. 34-36) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003 fail to address the rejection that **the phrase "at least one"** as a modifier of "mono-sectional body" **is drawn to new matter**. Appellant's remarks in Amendment C (pgs. 34-36) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003 are **solely directed to the language "mono-sectional body"** when the Final Office action (pg. 2, last two lines) mailed September 11, 2002 specifically states, **"Therefore, the phrase, 'at least one,' as a modifier of 'mono-sectional body' is drawn to new matter."**

Appellant's argument in Amendment C (pg. 36) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003 regarding the rejection of claim 49 under 35 USC 112, first paragraph fail for the reason previously set forth since claim 49 includes the new matter of claim 45.

Regarding appellant's arguments in Amendment C (pgs. 36-37) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003

concerning the rejection of claims 68-70 under 35 USC 112, first paragraph, appellant remarks that the original specification supports the combination of a dry adhesive and a low tack adhesive. However, appealed claims 68-70 recite, "at least one layer of a repositionable adhesive and at least one layer of a dry adhesive". **Neither appellant's original specification nor arguments explicitly state the "repositionable adhesive" as is now being claimed to mean, or is the same as, "low tack adhesive".** Page 13, 8th paragraph of appellant's original specification **does not explicitly state the "repositionable adhesive" as is now being claimed to mean, or is the same as, "low tack adhesive".** Page 14, 10th paragraph of appellant's original specification **does not explicitly state the "repositionable adhesive" as is now being claimed to mean, or is the same as, "low tack adhesive".** Page 15, 8th paragraph of appellant's original specification **does not explicitly state the "repositionable adhesive" as is now being claimed to mean, or is the same as, "low tack adhesive".** Pages 16, 1st paragraph of appellant's original specification **does not explicitly state the "repositionable adhesive" as is now being claimed to mean, or is the same as, "low tack adhesive".** Page 17, lines 1-4 and the last two lines of appellant's original specification **does not explicitly state the "repositionable adhesive" as is now being claimed to mean, or is the same as, "low tack adhesive".** Page 18, 10th paragraph of appellant's original specification **does not explicitly state the "repositionable adhesive" as is now being claimed to mean, or is the same as, "low tack adhesive".** Page 19, 3rd and 9th paragraphs of appellant's original

specification **does not explicitly state the “repositionable adhesive” as is now being claimed to mean, or is the same as, “low tack adhesive”.**

Appellant's arguments concerning the rejection of claims 45-53 under 35 USC 112, second paragraph are moot since the Examiner is no longer maintaining that rejection.

In response to appellant's arguments in Amendment C (pgs. 56-59) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003, that Schieman is not a “self sealing letter sheet” or a “self sealing form” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding appellant's argument in Amendment C (pgs. 56-57) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003 that Schieman does not disclose a “mono-sectional body”, the Examiner maintains that the body of Schieman is mono-sectional to the degree that the body is formed from a unitary (i.e. single) sheet of material. There is nothing in appellant's original specification that explicitly precludes an envelope that is made from a unitary sheet of material from reading on a “mono-sectional body”. The Examiner is not acting as his own lexicographer, as alleged by appellant in the September 08, 2003 reply brief. The

Examiner is merely assigning to appellant's claims their broadest, reasonable interpretation.

In response to appellant's argument in Amendment C (pg. 58) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003 that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., "each flap needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired", see pg. 18, 7th paragraph and pg. 19, lines 1-3 in the appeal brief filed March 07, 2003) are not recited in appealed claims 45 and 62. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellant's argument in Amendment C (pgs. 59-63) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003 that Schieman and Wilbur are nonanalogous art with respect to Johnson, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Johnson is in the field of appellant's endeavor (letter sheets and forms having sealing flaps). Schieman and Wilbur are reasonably pertinent to a particular problem with which appellant was concerned. One specific problem on page 2, lines 18-20, of appellant's original specification states,

"6) Some of these systems require adhesive coatings to be moistened to promote adhesion...incurring thereby in additional steps and costs."

Regarding appellant's argument in Amendment C (pgs. 61-62) filed October 17, 2002 that commercially producing the letter sheets of Johnson with the incorporated a tear string poses a serious problem, appellant is reminded the method of forming the device is not germane to the issue of patentability of the device itself.

In response to appellant's argument in appellant's appeal brief filed March 07, 2003 that the present invention is to be suitable for laser printers and other friction and heat generating machines, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Appellant's remark on pages 22-24 of the appeal brief filed March 07, 2003 that, "the incorporation of interactive release and pressure sensitive adhesive is not compatible with Johnson's invention..." is opinion and fails to overcome the combination of the prior art as a whole. Furthermore, there is nothing in Johnson that precludes "the incorporation of interactive release and pressure sensitive adhesive". Pages 53-55 of Amendment C filed October 17, 2002 and pages 22-24 of the appeal brief filed March 07, 2003 fail to specifically indicate where in the

Johnson reference the explicit statement that the incorporation of interactive release and pressure sensitive adhesive is impossible or undesirable.

In response to appellant's argument Amendment C (pgs. 59-66) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief (pgs. 20-21) filed September 08, 2003 that there is no motivation to combine the envelopes of Schieman or Wilbur with the letter sheet of Johnson in order to arrive at appellant's claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the present case, Schieman and Wilbur each suggest that it is desirable to provide adhesive inhibitors on mailing assemblies having adhesive flaps in order to prevent premature adherence of the flaps.

Regarding appellant's "Affidavit 1" of "long felt need", filed on May 20, 2002, (and referred to in Amendment C (pgs. 62-63) filed October 17, 2002) appellant's affidavit fails to show that the need has been a persistent one that was recognized by persons having ordinary skill in the art.

Appellant argues in Amendment C (pgs. 63-66) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief (pg. 22) filed September 08, 2003 that, "Stenner is a multiple envelope with enclosures, which disqualifies it as a reference against a self sealing letter sheet. Thus, it is inconceivable that an envelope, and a

reply sheet be combined with a piece of 'direct mail' with plurality of envelopes and enclosures because they all relate to different species." Appellant's argument is opinion. Furthermore, appellant's reiteration of the structure disclosed by Stenner does not refute the desirability of Stenner to provide a plurality of forms in series, separated by lines of perforations in order to mass produce forms.

Appellant's argument in Amendment C (pg. 61) filed October 17, 2002, appeal brief filed March 07, 2003 and reply brief filed September 08, 2003 that "Johnson teaches away from the combination proposed by the Office" is not persuasive because Johnson was not applied in the rejections as a secondary, or teaching, reference, but instead as the primary reference.

Regarding the reply brief filed September 08, 2003, appellant's remark that the arguments on page 26 of Amendment C filed October 17, 2002 are related to non-entered, amended claims 45, 49, 50, 53, 54, 57, 62, 67 and 68 is correct.

In the reply brief filed September 08, 2003, appellant remarks on page 13 that the Response to Argument in the Examiner's Answer mailed August 26, 2003 "is trying to present 'new' new matter rejection". The Examiner disagrees. Paragraph 7 of the Final Office action mailed September 11, 2002 recites, "There is no original disclosure of a letter sheet having one layer of repositionable adhesive and one layer of a dry adhesive." The Examiner's Answer mailed August 26, 2003 and the present Supplemental Examiner's Answer is merely buttressing this statement by pointing out that the language "repositionable adhesive" is not found in the four corners of

appellant's original specification. Nor is it found in appellant's original specification that a "low tack adhesive" is the same as a repositionable adhesive.

In the reply brief filed September 08, 2003, appellant remarks on page 14, "The argument by the New Examiner that 'the self sealing letter sheet' or 'the self sealing form' occur in the preamble is also new". The Examiner's remarks regarding appellant's preamble merely buttress the statement on page 7, 2nd paragraph of the Final Office action, "Applicant's arguments are not persuasive of patentability because they focus on what the claimed invention is not, rather than on what the claimed invention is and how it differs from the prior art." Appellant's submission attachments 11-14 and attachments 15-31 in Amendment C have been considered, but is not convincing evidence that the envelope of Schieman neither implicitly nor explicitly read on the "self sealing letter sheet" or a "self sealing form" recited in the preamble of appellant's claims.

In the reply brief filed September 08, 2003, appellant remarks on page 19, paragraph 5 the "Examiner also submits new arguments related to 'process of making' claims. This remark by the Examiner's was made in response to appellant's argument in Amendment C (pgs. 61-62) that commercially producing the letter sheets of Johnson with the incorporated a tear string poses a serious problem.

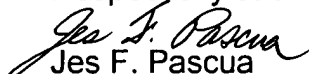
In response to appellant's argument on pages 16-18 of the reply brief filed September 08, 2003 that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long

as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant alleges on page 23 of the reply brief filed September 08, 2003, that all remarks in the Examiner's Answer are new. Appellant is reminded that there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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JFP
July 19, 2004

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